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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,013	11/04/2003	Rory A.J. Curtis	004974.01183	7317

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EXAMINER

ALLEN, MARIANNE P

ART UNIT	PAPER NUMBER
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1647

MAIL DATE	DELIVERY MODE
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07/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/701,013

Applicant(s)

CURTIS ET AL.

Examiner

Marianne P. Allen

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 1647

DETAILED ACTION

Applicant's arguments filed 1/8/07 and 4/27/07 have been fully considered but they are not persuasive.

Claims 59-60 have been cancelled. Claims 40-58 are under consideration.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. The certified copy of PCT/US00/05409 was submitted 5/3/07.

Applicant is again requested to update the status (i.e. patented, abandoned) of the applications referenced in the first sentence(s) of the specification following the title. Applicant's response on 1/8/07 did not completely update the continuing information.

Claim Rejections - 35 USC § 112

Claims 40-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

This rejection is maintained for reasons of record.

Applicant submitted a copy of the deposit slip. However, this is insufficient to satisfy MPEP 2402. Applicant has not submitted any copies of the documentation from the parent

Art Unit: 1647.

application to complete this file and obviate this rejection. Applicant is advised to review the prosecution history of the parent applications with respect to this deposit.

The concept of “contacting a sample comprising a polypeptide” was not seen. (See for example, claim 40, 47, and 54.) Applicant has pointed to page 52, lines 8-11. This is not agreed with. At least for example, page 52, lines 8-11, discloses a cell-free assay. This is not a limitation of the claims.

The concept of a method for identifying a compound using “a polypeptide comprising a fragment of at least 15 contiguous amino acids” was not seen. (See for example, claim 54.) Applicant has pointed to page 7, lines 7-10. This is not agreed with. At least for example, the disclosure on page 7, lines 7-10, is not with respect to reagents for binding assays.

The concept of a method for identifying a compound using a polypeptide with the limitations of claims 41, 48, or 55 was not seen. Applicant has pointed to page 7, lines 23-25. This is not agreed with. At least for example, the disclosure on page 7, lines 23-25, is not with respect to reagents for binding assays.

The generic limitation of claim 45 and 52 for any activity of the polypeptide was not seen. Applicant has pointed to page 7, lines 35-38. This is not agreed with. This discloses particular activities and not the general concept of any activity.

Basis for the particular activities in claims 46 and 53 was not seen. Applicant has pointed to pages 51, lines 8-9; page 23, lines 28-31; and page 52, lines 1-3. This is not agreed with. At least for example, page 51, lines 8-9, discloses an assay where neurotransmitter is released from a cell that expresses TWIK. At least for example, measuring membrane

Art Unit: 1647

excitability is not synonymous with measuring membrane excitability. At least for example, detecting induction of a cellular second messenger is not synonymous with measuring cellular signaling.

Basis for the general concept of “immunoassay” in claims 44, 51, and 58 was not seen. Applicant has pointed to page 36, lines 27-29. This is not agreed with. “Immunoassay” is a broader concept than detecting a protein with an antibody to evaluate the abundance and pattern of expression.

As set forth in the prior Office action, claim 45 recites that the binding of the test compound to the polypeptide is detected by an assay for an activity of the polypeptide. The only activities that appears to be disclosed are potassium channel activity as recited in claim 1 as reflected in the assays recited in claim 46. No other activities or ways of determining activity appear to be set forth. See also claims 52-53. Applicant does not appear to have responded to this portion of the rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1647

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712.

The examiner can normally be reached on Monday-Friday, 5:30 am - 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol can be reached on 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marianne P. Allen

Marianne P. Allen
Primary Examiner
Art Unit 1647

7/5/07

mpa